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EXAMINER
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ELOSHWAY, NIKI MARINA

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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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*Ex parte* MARK R. JOHANSEN

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Appeal 2008-6204  
Application 09/606,702  
Technology Center 3700

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Decided:<sup>1</sup> February 25, 2009

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Before DONALD E. ADAMS, LORA M. GREEN, and  
JEFFREY N. FREDMAN, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

**DECISION ON APPEAL**

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 23, 25, 26, and 28-36. We have jurisdiction under 35 U.S.C. § 6(b).

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

## STATEMENT OF THE CASE

The claims are directed to a method of forming a fuel container.

Claim 23 is representative of the claims on appeal, and reads as follows:

23. A method of forming a fuel container with an opening and a cap sealing the opening, comprising the steps of:
- providing a pair of mold halves defining a first mold cavity to form and define the shape of a container from a parison by blow molding and adjacent the first cavity a second cavity to form at least one cap in a flash section from the parison by compression molding;
  - providing a parison with a hydrocarbon fuel vapor barrier layer of a polymeric material disposed between inner and outer layers of a different polymeric material which is heat weldable;
  - closing the mold halves together to receive and compress a portion of the parison between them forming at least one flash section in the region of the second cavity and at least one cap in the second cavity in the flash section by compression molding;
  - providing a pressurizing fluid into the parison within the closed mold halves to expand the parison within the first mold cavity to form the entire container and define the shape of the container by blow molding;
  - forming an opening through the container at a location spaced from the cap;
  - before filling the container, separating the cap from the flash section;
  - before filling the container, disposing the cap over the opening; and
  - before filling the container, heat welding the cap to the container circumferentially continuously to permanently attach and seal the cap to the container to permanently close, seal and provide a fuel vapor barrier for the opening.

The Examiner does not rely on any evidence.

We reverse.

## ISSUE

The Examiner concludes that the limitation “before filling the container” added to the steps of “separating the cap from the flash section”,

“disposing the cap over the opening” and “heat welding the cap” is new matter.

Appellant contends that filling the container with any hydrocarbon fuel, even if drained before heat welding, would be inherently dangerous because of the potential of an explosion of fuel vapors by the heating to elevated temperatures of the plastic material during the heat welding, blow molding, and co-extrusion to form the hollow parison.

Thus, the issue on Appeal is: Does the limitation “before filling the container” added to the steps of “separating the cap from the flash section”, “disposing the cap over the opening” and “heat welding the cap” constitute new matter?

#### FINDINGS OF FACT

FF1 The Specification teaches that “[e]nvironmental concerns and regulations have spurred the need to reduce the amount of hazardous hydrocarbon vapors emitted by vehicles and have led to the development of new technologies for manufacturing plastic fuel tanks.” (Spec. 1.)

FF2 According to the Specification, such tanks had a separate monolayer cap formed by a separate molding process, but that such caps permit fuel vapor to permeate therethrough (*id.* at 2).

FF3 The Specification teaches a cap for a fuel tank that has the same properties of the fuel tank, and that the cap may be fixed or welded to the fuel tank over an opening through the tank (*id.*).

FF4 The cap “is formed simultaneously with a blow molded article and within flash sections . . . formed during production of the molded article to

reduce the overall waste or scrap material and to eliminate the need for secondary processing operations to form the cap. . . . [T]he cap . . . may be formed from the same material as the blow molded article and thus, may have the multiple layer construction of the blow molded article and the desirable characteristics of each layer and may even have two of each layer of material.” (*Id.* at 8.)

FF5 The Examiner rejects claims 23, 25, 26, and 28-36 under 35 U.S.C. § 112, first paragraph, as containing new matter (Ans. 2-3).

FF6 The Examiner finds that the limitation “before filling the container” added to the steps of “separating the cap from the flash section”, “disposing the cap over the opening” and “heat welding the cap” to be new matter (*id.* at 3).

FF7 According to the Examiner, the disclosure as filed “did not state at which point, during the manufacture of the container, the container is filled with fuel or any other substance.” (*Id.*) The Examiner further finds that the disclosure as filed never mentions filling of the container (*id.*)

FF8 The Examiner also finds that the container could be filled with a liquid or fuel prior to permanently attaching the cap to the container for testing purposes or to cool the container down to room temperature any time after blow molding (*id.* at 4).

FF9 The Examiner finds further that the limitation “before filling the container” is not limited to filling the container with fuel, and in fact, the container is filled with air during the blow molding process (*id.*).

## PRINCIPLES OF LAW

The disclosure as originally filed need not provide “*in haec verba*” support for the claimed subject matter at issue,” rather, the disclosure should convey to one skilled in the art that the inventor had possession of the invention at the time of filing. *Purdue Pharma L.P. v. Faulding Pharmaceutical Co.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000) (citations omitted).

In addition, we recognize that during prosecution before the Office, claims are to be given their broadest reasonable interpretation consistent with the Specification as it would be interpreted by one of ordinary skill in the art. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). However, “the claims themselves provide substantial guidance as to the meaning of particular claim terms.” *Philips v. AWH Corp.*, 415 F.3d 1301, 1314 (Fed. Cir. 2005) (en banc).

## ANALYSIS

Appellant argues that “persons of ordinary skill in the art knew and understood when this application was filed that during manufacture of plastic fuel tanks by extruding or forming and then blow molding a parison to form the tank body and thereafter separating and attaching a cap to the tank, the tank was not filled and certainly was not filled with fuel because it would be hazardous and detrimental to manufacture of the fuel tank.” (App. Br.<sup>2</sup> 12.) According to Appellant, “filling the container with any

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<sup>2</sup> All references to the Appeal Brief (App. Br.) are to the Substitute Appellant’s Brief dated May 9, 2005.

hydrocarbon fuel even if drained before heat welding would be inherently dangerous because of the potential of an explosion of fuel vapors by the heating to elevated temperatures of the plastic material during the heat welding, blow molding, and co-extrusion to form the hollow parison.” (*Id.* at 13.)

We find that Appellant has the better position. Claim 23 is drawn to a “method of forming a fuel container with an opening and a cap sealing the opening.” Thus, we interpret the limitation “before filling the container,” in view of the preamble and the teaching of the Specification of forming a plastic fuel tank with a cap (FF1-FF4), as being filled with fuel before the final construction of welding the cap to the tank. In addition, as the final step is heat welding the cap to the container, we agree with Appellant that the ordinary artisan would understand that such welding would occur before any fuel is added to the tank.

#### CONCLUSIONS OF LAW

We find that the limitation that “before filling the container” added to the steps of “separating the cap from the flash section”, “disposing the cap over the opening” and “heat welding the cap” does not constitute new matter.

We thus reverse the rejection of claims 23, 25, 26, and 28-36 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement for containing new matter.

REVERSED

Appeal 2008-6204  
Application 09/606,702

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